

# FOLEY

December 20, 2004

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CLIENT/MATTER NUMBER  
084561-0122

## VIA E-MAIL ONLY

Mark Landesmann  
*BuyerLeverage*  
300 Hamilton Avenue  
4th Floor  
Palo Alto, CA 94301

Re: U.S. Patent Application No.: 10/727,535  
Filing Date: 12/05/2003  
Title: BUYER PROFILE MANAGEMENT  
Inventor(s): Mark LANDESMANN  
Our Ref.: 084561-0122

Dear Mark:

Enclosed is a copy of the first Office Action from the U.S. Patent and Trademark Office, dated December 14, 2004, and relating to the above-identified patent application.

A response to this Office Action must be prepared and filed by March 14, 2005 in order to avoid the payment of extension fees. We shall prepare and file an appropriate response to the Office Action by the due date. However, before we do, please review these documents and provide us with your comments regarding the specific differences between the invention and the teachings suggested by the cited prior art. If you have any suggestions with respect to amending the claims to distinguish the invention from the prior art, feel free to include them.

Please note that we are still under a duty of disclosure to the U.S. Patent and Trademark Office, so if you or any of the inventors have become aware of any additional information relevant to the invention, please let us know.

Please note that with the patent term now being 20 years from the date of filing, the patent term may be extended if the PTO causes a delay in patent issuance. However, if the Applicant causes a delay in prosecution, any patent term extension may be diminished by such delay. An example of such delay caused by Applicant is an "extension of time" necessitated by failure to respond within the time period set by the Examiner in an office action. Thus, it is essential that your comments relative to the references be received as soon as possible so that we may have sufficient time in which to prepare and file a response within the time deadline set by

002.1135522.1

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**FOLEY:LARDNER**

Mark Landesmann  
BuyerLeverage  
Page 2

the Patent Office.

Of course, if you have any questions, please do not hesitate to contact me.

Very truly yours,



William T. Ellis

WTE/ba  
Enclosure(s)



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,535	12/05/2003	Mark Landesmann	084561-0122	7340
22428	7590	12/14/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			LE, KHANH H	
		ART UNIT	PAPER NUMBER	
		3622		

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/727,535	LANDESMANN, MARK	
	Examiner Khanh H. Le	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (8) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 December 2003 and April 5, 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/5/03.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. This Office Action is in response to the original application and the Preliminary Amendment dated April 5, 2004. The amended specifications have been entered. Claims 1-22 are pending with claims 1, 21,22 being independent.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 12-14, 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 12, 13, 14 and 19 should be dependent on claims 11, 11, 10, and 18 respectively to have proper antecedent basis. Appropriate correction is required.

### **Claims Rejections. 35 U.S.C. 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber, US 5855008, hereinafter Goldhaber in view of Day, US 6484146, hereinafter Day.**

Goldhaber discloses:

A consumer driven system ( i.e. consumer owns the profiles : col 14 l. 56-60; col 6 l. 28-35; consumer shares these profiles as desired: col 8 l. 40-57), via trading houses (see col 19-20) , for the benefit of both consumers and advertisers ( col 4 l. 25-31).

The benefit to consumers is to receive competing content/ads customized to their needs/preferences. To advertisers, use of consumer profiles allow reaching more willing customers whose attention has been secured w/ relevant customized ads/offers.

GOLDHABER further discloses actual purchase histories ( or proofs of purchases, hereinafter, "POP's") are known to be valuable for advertisers: to this end advertisers have used point of sale tracking (see GOLDHABER ., col 6 l. 28-35), and GOLDHABER .'s invention includes on-line POP's (col 6 l. 50-65; col 13-20; col 7 l. 31-32).

GOLDHABER discloses user voluntary submission of profiles in exchange of a benefit from plural competing independent providers(col 8 l. 1-18; receipt of targeted information, specialized targeted ads ( col 6 l. 28-35; col 8 l. 22-40), payments for viewing ads); complementing the profile by allowing tracking of on-line behavior including on-line transactions (POP's) (col 6 l. 50-65; col 13-20; col 7 l. 31-32) and tracking of other habits (col 6 l. 50-65) ; interactive user editing/ deletion of transaction records from the profile (col 6 l. 50-65); protection of privacy (col 7 l. 62-67;col 14 l. 137 -39); interacting with presented ads (col. 16 l. 17-20) ; rating of presented ads (col. 13 l. 50-51); matching of consumers to advertisers criteria ( col 14 l. 30-46); consumer profiles stored at their PC or in another database of the on-line system ( col 14 l. 47-54); only information matched above certain threshold set by the consumer is delivered ( col 14 l. 56-62); coupons and discount offers to induce buying (col 3 l. 30-45); internet advantages (col 3 l. 48-55); credit histories as commodities ( col 20 l. 38-55).

**Summary of Day:**

Day discloses presenting specialized benefits based on actual purchasing behavior information (abstract). Day teaches the desirability of knowing who buys from competitors so to provide competitive offers (col. 1 l. 50-55; col.2 l. 13-15; col. 2 l. 12+). Day also discloses the desirability of using actual purchasing records, other than at the electronic point of sales, in order to achieve that relevant targeting goal (col. 1 l. 60-col.2 l. 2).

Thus as to claims 1, 6-7 GOLDHABER discloses

A computer-implemented advertising method, and program comprising:  
storing a first data set relating to the purchases of a buyer entity in a storage (col 6 l. 50-65; col 13-20; col 7 l. 31-32; col 6 l. 50-65);  
receiving profile-management-information from the buyer entity (col 6 l. 50-65; col 13-20; col 7 l. 31-32) ;  
identifying a second data set based on the first data set and based on the profile-management-information ( col 14 l. 30-46).

GOLDHABER does not specifically disclose but Day does discloses  
calculating at least one score based on information in the second data set (see at least col. 4 line 18-3: "targeted parameter" is a score) ;

distributing preferential incentive offers to said buyer entity, based on the score (see at least col. 4 line 18-31)

It would have been obvious to one skilled in the art at the time the invention was made to add Day ads matching method based on scores to GOLDHABER's ad targeting method to improve this latter with further implementation details.

As to claims 2-4, and 8, GOLDHABER discloses

wherein said profile-management-information is deletion-information (see at least col. 6 lines 50-65), and wherein the second data set (e.g. allowed data) is identified by separating third data (e.g. non-allowed data) from the first data set based on the deletion-information;

wherein said profile-management-information contains enhancement permissions, and wherein the second data set is identified by augmenting the first data set based on fourth data from a third party information source (see at least col. 6 lines 50-65, col. 20 line 38-55: credit histories);

wherein a group of multiple incentive offers are stored in a database, information relating to at least one web site visit(see at least col. 6 lines 50-65), is used to select at least one incentive offer from said group, and said at least one incentive offer is displayed to the buyer entity;

and wherein the buyer entity disqualifies some of its purchase records from being used for calculating said score (see at least col. 6 lines 50-65).

As to claim 5 , Official Notice is taken that incentives given conditioned on the use of certain credit cards are well-known to promote the use of such cards. It would have been obvious to one skilled in the art at the time the invention was made to add a credit card use condition to the incentives method of GOLDHABER/DAY for the above-mentioned advantage.

As to claim 9-10 , GOLDHABER does not specifically disclose but Day discloses receiving additional data associated with the buyer entity; associated with previous incentive responses by said buyer entity;

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automatically updating the at least one score associated with the buyer entity, based on the additional data; and

changing at least one aspect of the incentives based on the at least one updated score

(see at least col. 4 lines 18-31, "targeting parameter" is interpreted as a calculated score based on data received indirectly from the buyer based on the quantity of goods bought, per categories, which is interpreted as "purchase records").

Thus it would have been obvious to one skilled in the art at the time of the invention to Add DAY's more detailed updated incentives method to GOLDHABER targeted incentive offering method to effect such incentives updating as at least suggested by GOLDHABER (interactive user editing/ deletion of transaction records from the profile: at col 6 l. 50-65).

As to claims 11-17, Day discloses

performing a process, including:

determining a function (see at least col. 4 lines 18-31, use of "targeting parameters" to derive an incentive implies use of a certain incentive function or relationship to link the parameter to the incentive) and a budget limit (see at least col. 14 lines 52-56, col. 6 lines 57-60: "maximum limit") of one of the incentives based in part on advertiser information received from an advertiser (see at least col. 4 line 18-31; col. 14 line 52-56; col. 6 line 57-60)

receiving newly-submitted purchase records of a plurality of the buyer entities

(see at least col. 7 line 66- col. 8 line 37)

determining a group of the buyer entities newly qualified to receive the incentives based on the function, budget limit, and newly-

submitted purchase records (see at least col. 4 line 18-31; col. 14 line 52-56; col. 6 line 57-60)

for each buyer entity in a subgroup comprising at least one buyer entity of the group of buyer entities, individually calculating an amount for at least one of the incentives by applying the at least one score to the function (see at least col. 4 line 18-31; col. 14 line 52-56; col. 6 line 57-60: Day's disclosure of monitoring of redemption of offers and modifying the offers based on the new data is interpreted as the earlier score (based e.g. on category) is being updated so that offers may be modified based on the new data.),

automatically distributing the at least one of the incentives to the buyer entity, and automatically repeating the process until the budget limit for the advertiser is met (see at least col. 14 lines 52-56, col. 6 lines 57-60: "maximum limit").

Thus it would have been obvious to one skilled in the art at the time of the invention to add DAY's updated incentives methods based on new records as applied to existing/new consumers, as above-discussed, to GOLDHABER's incentive offering method to make this latter's incentive matching system more comprehensive.

As to claims 18-19, both GOLDHABER and Day disclose providing an interface to provide access for a plurality of the advertisers to a database of database information related to the buyer entities, the interface receiving queries and providing the database information in response to the queries, such that decisions are capable of being made regarding the incentive: based on the database information (see at least Day, abstract, Fig. 5 and associated text).

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As to claim 20, GOLDHABER discloses a different personalized web site is displayed to each of a plurality of the buyer entities, and individually ranks a plurality of the incentives based at least in part on an amount of the incentives (see at least Figs. 4 and 11 and associated text).

Claims 21-22 are combinations of claims 1, 8-9, 4, and 11-17. Each limitation is rejected as above discussed. It would have been obvious to one skilled in the art at the time the invention was made to combine all the above elements to make a more comprehensive system.

### **Conclusion**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

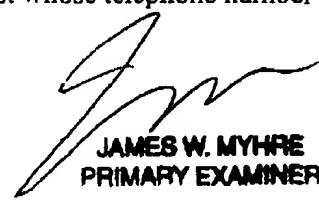
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

December 8, 2004

khl

KHL



JAMES W. MYHRE  
PRIMARY EXAMINER

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Substitute for form 1448B/PTO <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>				Complete // Known	
Date Submitted: <b>DEC 05 2001</b> (use as many sheets as necessary)				Application Number	Unassigned
				Filing Date	DEC 05 2001
				First Named Inventor	Mark LANDESMANN
				Group Art Unit	Unassigned
				Examiner Name	Unassigned
				Attorney Docket Number	084581-0122
Sheet	1	of	2		

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY
		Number	Kind Code <sup>2</sup> (if known)		
KHL	A1	5,327,508		DEATON et al.	07-1997
	A2	5,592,580		DEATON et al.	01-1997
	A3	5,842,485		DEATON et al.	03-1997
	A4	5,844,723		DEATON et al.	07-1997
	A5	5,849,114		DEATON et al.	07-1997
	A6	5,724,521		DEDRICK	03-1998
	A7	5,774,970		STOREY	08-1998
	A8	5,784,207		WALKER et al.	08-1998
	A9	5,797,127		WALKER et al.	08-1998
	A10	5,822,735		De LAPA et al.	10-1998
	A11	5,855,008		GOLDHABER et al.	12-1998
	A12	5,884,277		KHOSLA	03-1999
	A13	5,897,820		WALKER et al.	04-1999
	A14	5,924,080		JOHNSON	07-1999
	A15	5,970,469		SCROGGIE et al.	10-1999
	A16	6,012,051		SAMMON, JR. et al.	01-2000
	A17	6,014,538		BURGE et al.	01-2000
	A18	6,049,777		SHEENA et al.	04-2000
	A19	6,055,513		KATZ et al.	04-2000
	A20	6,055,573		GARDENSWARTZ et al.	04-2000
	A21	6,061,580		EGGLESTON et al.	05-2000
	A22	6,084,877		CAPEK et al.	07-2000
	A23	6,134,532		LAZARUS et al.	10-2000
	A24	6,185,541		SCROGGIE et al.	02-2001
	A25	6,233,878	B1	TUZHILIN	05-2001
	A26	6,288,330	B	GARDENSWARTZ et al.	10-2001
	A27	6,327,574	B1	KRAMER et al.	12-2001
	A28	6,332,126	B1	PEIRCE et al.	12-2001
	A29	6,415,262	B1	WALKER et al.	07-2002
	A30	6,434,534	B1	WALKER et al.	08-2002

FOREIGN PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document		Name of Patentee or Applicant of Cited Documents	Date of Publication of Cited Document MM-DD-YYYY
		Office <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup> (if known)	
A31	WO	00/62184		NG	10-2000

Examiner Signature	<i>Clyne</i>	Date Considered	12/4/04
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\*EXAMINER: initial if references considered, whether or not action is in conformance with MPEP 608. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup>Unique citation designation number. <sup>2</sup>See Cited Kind of U.S. Patent Document. <sup>3</sup>Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup>For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the cited number of the patent document. <sup>5</sup>Kind of document by the appropriate symbol as indicated on the document under WIPO Standard ST. 16 if practicable. <sup>6</sup>Applicant to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, PO Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, PO Box 1450, Alexandria, Virginia 22313-1450.

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Substitute for form 1449B/PTO				Complete If Known	
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>				Application Number	Unassigned
Date Submitted: DEC 05 2003 (use as many sheets as necessary)				Filing Date	DEC 05 2003
Sheet	2	of	2	First Named Inventor	Mark LANDESMANN
				Group Art Unit	Unassigned
				Examiner Name	Unassigned
				Attorney Docket Number	084561-0122

## **NON-PATENT LITERATURE DOCUMENTS**

Examiner Signature	<u>Choufani</u>	Date Considered	12/4/04
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**\*EXAMINER:** Initial if reference considered, whether or not citation is in conformance with MPEP 608. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup>Unique citation designation number. <sup>2</sup>See attached Kinds of U.S. Patent Documents. <sup>3</sup>Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup>For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document.

<sup>3</sup>Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>4</sup>Applicant is to place a check mark here if English language Translation is attached.

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<b>Notice of References Cited</b>		Application/Control No. 10/727,535	Applicant(s)/Patent Under Reexamination LANDESMANN, MARK	
		Examiner Khanh H. Le	Art Unit 3622	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
A	US-5,855,008	12-1998	Goldhaber et al.	705/14
B	US-6,484,146	11-2002	Day et al.	705/14
C	US-			
D	US-			
E	US-			
F	US-			
G	US-			
H	US-			
I	US-			
J	US-			
K	US-			
L	US-			
M	US-			

**FOREIGN PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
N					
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**NON-PATENT DOCUMENTS**

*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages		
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\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.